

## REMARKS

### **Formal Matters**

Claims 13 and 15-26 are pending; each of the claims has been rejected. Claims 22, 23 and 25 are amended. No new matter or new issues are introduced by virtue of the amendments – thus this Amendment should be entered and given full consideration. The claim amendments are solely for the purpose of addressing the claim objections and rejections under 35 USC§112.

### **Claim Objection and Rejections**

The claims have been amended to handle the issues noted by the Examiner. The Examiner's attention in noting the typographical error in claims 23 and 25 is appreciated. Regarding the rejection of claims 22-26 under §112, while Applicant respectfully disagrees with the basis, the claims have been amended in the spirit of cooperation and moving the application forward toward allowance.

### **35 USC §102**

Claims 13 and 15-20 are rejected as being anticipated by Boxer; claims 13, 19 and 20 are rejected as anticipated by Gleason et. al. In formulating each of the rejections, it was stated that their references disclose at least one of the at least two compartments filled with a thermal capacitance medium. In Boxer, the asserted “thermal capacitance medium” is called out by the Examiner as element (80). For Gleason, it is indicated as element (28).

Regarding independent claim 13, the following paragraph from Applicant's specification specifically defines (via lexicography) the nature of the “thermal capacitance medium”:

In each variation of the present invention, thermal medium 24 may be water, a gel or other material that may be effectively chilled and/or heated. The material or materials chosen should have a high specific heat or heat capacity in order to best cool and/or heat or maintain a low or a high temperature of fluid within the pouch 4. A preferred medium 24 for cooling comprises a non-toxic refrigerant gel of conventional formulation. Compositions that may be suitable for medium 24 include water and propylene glycol or a cellulose ether, those described in U.S. Patent Nos. 6,044,201 to Van Turnhout and 5,035,122 to Oogjen (and references cited in each), those used/produced by Consolidated Products and Services, Inc. (Braintree, MA), or as used in commercially available gel packs for cooling and/or heating including Nexpare™ (3M: St. Paul, MN), PolyBag™ (Super Ice Corporation: San Leandro, CA).

Page 6, lines 6-15. Throughout the application, this thermal capacitance medium is given different meaning and treatment than simple insulation. No fair reading of the preceding paragraph and the remainder of the

subject application would result in a member of the informed public regarding insulation and the “thermal capacitance medium” as equivalent. The examiner should not either.

Since both Boxer and Gleason merely disclosure the use of an “insulation” layer (as stated in the very words of the references) in their systems and, thus, have no “thermal capacitance medium” as in Applicant’s claims (with a meaning as required by the specification), the rejection should be withdrawn.

In addition, Gleason fails to include a system where its plurality of layers are “all joined together to form at least two compartments ...” In order to support a case for anticipation, so-much is required. It is clearly the case in Gleason that no such a relation of elements exists. Oddly, Applicant is under the impression that the Examiner is actually in agreement with this statement. This belief is based upon the observation that the Boxer-based rejection recites that the layers are all joined. In contrast, no such assertion is made in the Gleason-based rejection. As such, it is not clear to Applicant why Gleason is being asserted as an anticipating reference, when the Examiner’s rejection does not even addresses all of the claim limitations. Consequently, the rejection based on Gleason should be withdrawn.

In addition, it is noted that the limitations of claims 15, 16 were not addressed relative to Boxer. Claims 15 requires that the pouch is formed by a first bag surrounded at least partially by a second bag; claim 16 requires that the pouch is formed by a first sleeve surrounded at least partially by a second sleeve. The present Office Action is completely silent as to these features. Hence, these claims are not believed to be properly rejected. Withdrawal of the rejection as it presently stands is therefore required.

As for the Examiner’s assertion that the Boxer insulation would inherently be a cooling or heating medium depending upon the temperature of the liquid, this asserting is neither supported nor does it take into account the legal requirements for inherency. If the Examiner it to maintain this rejection (despite the above remarks distinguishing mere insulation from a thermal capacitance medium) reference to the MPEP is suggested in order that the proper standard for inherency be applied during subsequent examination. Presently, the rejection is legally flawed and this matter with be the subject of appeal if not corrected.

### **35 USC §103**

Claims 23-26 were rejected over Harris in view of Johnston. Yet, (contrary to the Examiner’s assertion) nowhere does Harris disclose providing a system in which a hydration pouch has a compartment for containing gel and another one for containing drinking fluid.

Specifically, the Examiner asserted that Harris discloses “providing a hydration pouch (60) having a compartment containing gel (Column 5, line 6) and an empty compartment for drinking fluid (Column 5, line 31) ....” As is consistent with actual text of Harris and its figures, the asserted “pouch” 60 is merely a “thermos insert.” Whether called a “pouch” or something else, this item simply does not have a compartment containing gel. Item 60 has only one compartment and that compartment is for containing drinking fluid. It simply does not possess two compartments as is implicit and required by the rejection. For this reason alone, the rejection should be withdrawn. Thus the claim limitations are not met and the rejection should be withdrawn, thereby resulting in allowance of claims 23-26.

Claims 13 and 15-22 were rejected over Fawcett in view of Boxer and further in view of Shatterfield. In making the rejection, the Examiner asserts that the Fawcett pouch would be substituted for the one in Boxer “since it is well known to insulate drinking bags.”<sup>1</sup> However, one would not be motivated to use the Boxer pouch in the Fawcett bag. The Fawcett bag is already fully insulated on its interior. There is no reason to add further insulation. Actually, the contrary is true. In the cycling application for which the Fawcett pack is clearly intended, weight is at a premium and simply adding more of something (furthermore - in another, more complex form) that the Fawcett system already has makes little or no sense.

In addition, the pouch in Boxer is not suited for inclusion within the Fawcett pouch. It forms part of a complex mounting system. It is asserted that one would not be motivated - looking at the Boxer system - to take its pouch, remove it from its sling/holster armature and then put it into a different-shaped secondary bag. As such, the rejection is viewed as a clear example of hindsight reconstruction that gives no weight to the reality of the differences and setting in which the selected references (Fawcett and Boxer) are used.

Last, in order to meet the limitation of the rejected claims requiring the presence of gel, further combination with Satterfield is proposed. Regarding the substitution of insulation for gel (the reason for adding Satterfield as a reference), the Examiner has asserted that “doing so would increase the thermal insulating factor and thermal conductivity.” While the Examiner is correct that doing so would increase the thermal conductivity, what purpose would this serve? Increasing the conductivity would result in a cool product becoming warm faster and vice versa. Alone, this has no value.

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<sup>1</sup> Assumably, the Examiner is making this substitution to meet the additional limitation of claims 21 and 22 in which the subject pouch is set within a separate wearable pack.

As for increasing both the thermal insulating factor and the thermal conductivity, it is asserted that this is a technical impossibility. These are reciprocal properties. As stated in Applicant's response dated April 3, 2003, "It is to be understood that there is an inverse or opposite relationship between the insulative properties of a material and that material's ability to conduct heat ...." This concept is basic and universally accepted. For example, as stated in *Thermodynamics, An Engineering Approach* by Cengel and Boles (Second edition, 1994) at page 95, "Materials such as copper and silver which are good electric conductors are also good heat conductors, and therefore have high  $k_t$  [thermal conductivity] values. Materials such as rubber, wood, and styrofoam are poor conductors of heat, and therefore have low  $k_t$  values." The latter materials are good insulators – especially Styrofoam (as it is a material often used for its low thermal conduction/good insulation properties in making portable coolers). Accordingly, if the rejection is to be maintained, some concrete reasoning supporting the asserted possibility of both "increase[ing] the thermal insulating factor and thermal conductivity" by the proposed insulation-for-gel substitution is believed necessary. Otherwise, the rejection fails by its misapplication of scientific principles.

As for the bare assumption that substituting gel for insulation is obvious, no adequate reasoning has been provided (the above-noted reasoning being totally incorrect from a scientific standpoint). Furthermore, no reference teaching that the substitution is obvious has been found. In fact, nothing supports the Examiner's assertion except hindsight reconstruction. Clearly, the misapplication of the physical principles of insulation and conductivity do not. As such, withdrawal of the rejection is requested.

### **Secondary Considerations**

The Examiner has still not provided any point-by-point treatment of the Secondary Considerations evidence submitted to date (either in this application or the parent application hereto). In his paper dated April 3, 2003, Applicant reminded the Examiner of the treatment required regarding proper evaluation of Secondary Consideration under MPEP §§ 107.07 and 716.01(B). No such treatment has been forthcoming despite repeated requests (in this and the parent case hereto).

Applicant inquires if there is some reason why the Examiner is not doing what is required under the MPEP (even under §132 of the patent statute) for the treatment of Secondary Consideration evidence. Applicant is only requesting that established Patent Office procedure be followed - and that the examination he has paid for be received - in full. Should it continue to be the case that the

Secondary Considerations evidence submitted in the referenced response (i.e., items 1-5) are not given full treatment (each item individually, in-turn), this matter will be taken up on Appeal.

In any case, it is believed that the present action cannot properly be made final since the Examiner has not yet provided any specific explanation regarding the merits of the Secondary Considerations evidence submitted to date. Hence, at minimum, withdrawal of the present Office Action's finality is believed to be in order.

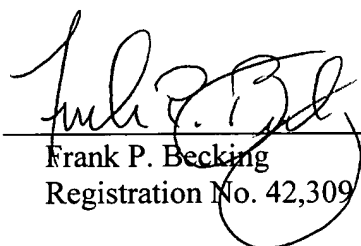
### Conclusion

Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number SKIL-001CON.

Respectfully submitted,  
BOZICEVIC, FIELD & FRANCIS LLP

Date: 1/8/04

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